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## PATENT

## THE UNITED STATES PATENT AND TRADEMARK OFFICE

<b>Applicant:</b>	Amy J. Donnan	<b>Examiner:</b>	D. Suhol
<b>Serial No.</b>	09/854,648	<b>Group Art Unit:</b>	3712
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<b>For:</b>	INTERACTIVE TOY AND METHODS FOR EXPLORING EMOTIONAL EXPERIENCE	<b>Docket No.</b>	DON0002/US/2

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Paula J. Breeden  
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APPEAL BRIEF

Dear Sir or Madam:

This Appeal Brief is being submitted in support of an Appeal from the Final Rejection mailed September 28, 2004, in connection with the above-identified patent application. Enclosed is a small-entity fee in the amount of \$250.00 for filing the Appeal Brief.

A Notice of Appeal was timely submitted on February 22, 2005, which according to PAIR, was received in the Patent Office on February 25, 2005. Two-months from actual receipt of the Notice of Appeal is April 25, 2005. Applicant respectfully petitions the Commissioner for Patents to extend the time-period for response for two months from April 25, 2005, to June 25, 2005. A fee of \$225.00 is enclosed herewith for the two-month extension. It is believed that no additional extension of time is required in order for this paper to be timely filed. However, if any additional extension period is required in order for this paper to be timely filed, then Applicant hereby requests an extension for such additional time period and authorizes the appropriate fee(s) therefore to be charged to the Kagan Binder Deposit Account No. 50-1775 and notify us of the same.

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It is believed that no other fee(s) are required in connection with the filing of this Appeal Brief. Should any additional fees be required, the Commissioner is authorized to charge such fee(s) to the Kagan Binder Deposit Account No. 50-1775 and thereafter notify us of the same.

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## **I. Real Party in Interest**

Amy J. Donnan is the real party in interest.

## **II. Related Appeals and Interferences**

There are no related appeals or interferences.

### **III. Status of Claims**

Claims 2, 3, and 5 have been canceled.

Claims 1, 4, and 6-18 are pending in the application.

Claims 6-9 and 12 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claims 13-16 and 18 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1, 4, and 6-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Van Hoose (U.S. Pat. No. 4,917,607) in view of Shaver et al. (U.S. Pat. No. 5,092,778).

Claims 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Van Hoose in view of Shaver et al. and further in view of Childswork/Childsplay “Feelings” Frog Game.

All theses rejections of claims 1, 4, and 6-18 are appealed.

#### **IV. Status of Amendments**

No amendments were filed subsequent to the final rejection mailed September 28, 2004.

## V. Summary of Claimed Subject Matter

The claimed invention relates to toys and methods that help explore an emotional experience by providing a plurality of playpieces such that each playpiece distinctly represents a particular emotion via a unique combination of individual playpiece features.<sup>1</sup> All pending claims 1-18 (especially both independent claims 1 and 13) feature, *inter alia*, an interactive toy that includes a plurality of playpieces where each playpiece is generally symbolic of a particular emotion and each playpiece includes the special combination of a unique color, a unique shape, and a unique visually discernable facial expression of the particular emotion having at least eyes and mouth. Claim 1 is exemplary and is reproduced as follows:

- An interactive toy for exploring an emotional experience, comprising:
- (a) a plurality of playpieces, each playpiece being generally symbolic of a particular emotion, and each playpiece comprising a unique color with respect to the other playpieces, a unique shape with respect to the other playpieces, and unique visually discernible facial expression with respect to the other playpieces of the corresponding particular emotion, said facial expression comprising eyes and a mouth; and
  - (b) a container comprising a storage chamber into which the playpieces may be independently stored or withdrawn during the course of play thereby providing the opportunity for emotions to be kinesthetically represented. (Underlining added for emphasis).

Providing a toy having individual playpieces with the unique combination of features, as claimed, advantageously enhances a person's (e.g., a child's) ability to connect a specifically identified emotion to a specific concrete symbol of that emotion (i.e., playpiece) during an otherwise fluid, sometimes overwhelming emotional experience.<sup>2</sup> Enhancing a child's ability to make this connection between a concrete symbol and a corresponding emotion helps provide a visual, kinesthetic, linguistic, and interactive process for learning that is more manageable and helps an adult or child plan for responsive actions.<sup>3</sup>

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<sup>1</sup> See the specification as originally filed at, e.g., page 3, lines 1-6 and page 5, lines 15-19.

<sup>2</sup> See id. at, e.g., page 7, lines 10-15.

<sup>3</sup> See id. at, e.g., page 7, lines 10-18.

Moreover, claims 17 and 18 (depending from claims 1 and 13, respectively) each include the interactive toy of their respective base claim, but additionally feature each of the plurality of playpieces with textual information indicative of the particular emotion of each playpiece.

## **VI. Grounds of Rejection to be Reviewed on Appeal**

- A. A first issue on appeal concerns whether claims 6-9 and 12 are definite and comply with the requirements under 35 U.S.C. §112, second paragraph.
- B. A second issue on appeal concerns whether claims 13-16 and 18 are directed to statutory subject matter under 35 U.S.C. §101.
- C. A third issue on appeal concerns whether claims 1, 4, and 6-16 are patentable under 35 U.S.C. §103(a) over Van Hoose in view of Shaver et al.
- D. A fourth issue on appeal concerns whether claims 17 and 18 are patentable under 35 U.S.C. §103(a) over Van Hoose in view of Shaver et al. and further in view of Childswork/Childsplay “Feelings” Frog Game.

## VII. Argument

### **A. Claims 6-9 and 12 are definite and comply with the requirements under 35 U.S.C. §112, second paragraph.**

#### **Claims 6-9**

Claims 6-9 stand rejected under 35 USC 112 on grounds that the shapes recited in these claims are indefinite. It is respectfully submitted that the terms “tear drop-shaped,” “sun-shaped,” “fire-shaped,” and “ghost-shaped,” as recited in claims 6-9, respectively, when considering the claims as a whole, and especially in view of the specification, satisfy Section 112. Moreover, it is respectfully submitted that reciting such shapes is a well-established practice as is evidenced by several issued U.S. patents noted below.

Each of claims 6-9 depends from claims 1 and 4 and each of claims 6-9 recites a specific shape of a playpiece that is generally symbolic of a particular emotion.

For example, claim 6 recites “wherein the playpiece generally symbolic of sadness is tear drop-shaped.” (underlining added for emphasis). It is respectfully submitted that one of skill in the art would understand the scope of claim 6 when reading claim 6 as a whole. Reading claim 6 as whole (i.e., reading both claims 1 and 4 as well) indicates that the playpiece generally symbolic of sadness is tear drop-shaped and has, *inter alia*, a “unique visually discernable facial expression with respect to the other playpieces of the corresponding particular emotion, said facial expression comprising eyes and a mouth.” (Underlining added for emphasis). One of skill would understand the scope of the term “tear drop-shaped” in the context of a playpiece generally symbolic of sadness that also includes, *inter alia*, a visually discernable facial expression corresponding to sadness, as claimed.

Similarly, it is respectfully submitted that one of skill in the art would understand the scope of each of claims 7-9 when reading each of claims 7-9 as a whole.

Representative users of the claimed toy are children, even young children. These youngsters have no difficulty identifying and discerning the recited shapes. If even youngsters can identify and discern amongst the claimed shapes, it seems implausible to assert that the claim terms are indefinite. Not only are these terms adequately described and

illustrated in the specification in a manner that satisfies Section 112, but use of such terms is well-established in the patent literature:

***The Specification:*** Applicant's specification provides exemplary embodiments of the specific shapes recited in claims 6-9 as follows:

- an exemplary embodiment of a “tear drop-shaped” playpiece, as recited in claim 6, is illustrated by the playpiece 16 in FIGS. 7a and 7b, which is generally symbolic of sadness and discussed throughout the specification, especially page 6, lines 6-10;
- an exemplary embodiment of a “sun-shaped” playpiece, as recited in claim 7, is illustrated by the playpiece 14 in FIGS. 5a and 5b, which is generally symbolic of happiness and discussed throughout the specification, especially page 5, lines 26-30;
- an exemplary embodiment of a “fire-shaped” playpiece, as recited in claim 8, is illustrated by the playpiece 18 in FIGS. 6a and 6b, which is generally symbolic of anger and discussed throughout the specification, especially page 6, lines 1-5; and
- an exemplary embodiment of a “ghost-shaped” playpiece, as recited in claim 9, is illustrated by the playpiece 20 in FIGS. 8a and 8b, which is generally symbolic of fear and discussed throughout the specification, especially page 6, lines 11-14.

***Well-established practice in the patent literature:*** Reciting shapes such as “tear drop-shaped,” “sun-shaped,” “fire-shaped,” and “ghost-shaped,” is a well-established practice as is evidenced by the following exemplary issued U.S. patents:

- U.S. Pat. No. 5,092,778 to Shaver et al. (relied on as a secondary reference in a 35 U.S.C. §103 rejection in the Final Office Action<sup>4</sup> and recites the shape term “teddy bear” in claim 5 to describe the shape of the “representational figure”);
- U.S. Des. Pat. No. 436,020 to Thomas (Claim recites coil hose hanger with “sun shaped” head member);
- U.S. Pat. No. 5,011,211 to Svensson (Claim 3 recites that rigid body has a “U-shaped” cross-sectional profile);
- U.S. Pat. No. 6,561,922 to Bamber (Claim 3 recites that a portion of a golf club has a “tear drop-shaped cross-section.”);

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<sup>4</sup> See, e.g., page 5 of the Final Office Action mailed September 28, 2004.

- U.S. Pat. No. 6,478,156 to Gebhardt (Claim 1 recites bags having a “tear-drop shaped support”);
- U.S. Pat. No. 6,554,336 to Huppi (claim 16 recites a suction body having a jacket that is “heart shaped”);
- U.S. Pat. No. 6,461,011 to Harrison (claim 1 recites an elongate “flame-shaped piece”); and
- U.S. Pat. No. 5,666,499 to Baudel et al. (claim 6 recites that a “ghost shaped image” is displayed).

It is respectfully submitted that the Examiner’s indefiniteness arguments against these shape features is improper. First, the Examiner improperly challenges whether the patent literature shows that using shape terms is a well-established practice. According to the Final Office Action<sup>5</sup>:

As support applicants list a variety of patents which use shape descriptive terminology, such as ‘teddy bear’, ‘tear-drop shape’, ‘heart shape’ among others. In response the examiner points out that none of the patents listed by the applicants appear to use terms such as, ‘sun-shaped’, ‘fire shaped’ or ‘ghost shape’ in the claim language.

It is respectfully submitted that this reasoning fails to fully appreciate the relevance of the issued patents cited by Applicants. The issued patents identified above were referenced to point out that reciting shapes the same as or similar to “tear drop-shaped,” “sun-shaped,” “fire-shaped,” and “ghost-shaped,” is a well-established practice in U.S. patent jurisprudence. Applicants note that, as indicated above, Thomas recites “sun shaped,” Baudel et al. recite “ghost shaped image,” and Harrison recites “flame-shaped piece,” which is similar to fire-shaped.

Second, the Examiner also improperly challenges the scope of the shape terms used in the claims. The Final Office Action<sup>6</sup> states that:

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<sup>5</sup> See id. at page 7.

<sup>6</sup> See id. at page 8.

[A] tear drop shape could be a variety of shapes such as a circle, oval, or blob with no clear defined boundaries, a sun shape can be a variety of shapes such as a circle, an oval, a half circle among others and as to a fire shape the examiner can't even begin to describe the variety of shapes that are encompassed by such a term.

In other words, inasmuch as the Final Office Action proposes that a variety of embodiments could be covered by the phrases “tear drop shaped,” “sun-shaped,” and “fire-shaped”, the Office Action is concerned not with indefiniteness, but rather the fact that the claim terms cover different embodiments. Of course, the Examiner confuses claim breadth with indefiniteness, which is contrary to MPEP 2173.04:

Breadth of a claim is not to be equated with indefiniteness... If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Clearly, the fact that the claim terms might cover multiple embodiments is not a proper basis for making an indefiniteness rejection.

In conclusion, it is respectfully submitted that claims 6-9 are definite and comply with the requirements under 35 U.S.C. §112, second paragraph. It is respectfully requested that the rejection of claims 6-9 under 35 U.S.C. §112, second paragraph, as being indefinite, be withdrawn.

### **Claim 12**

Applicant notes that, as indicated above, claim 12 stands rejected under 35 U.S.C. §112, but that the Final Office Action does not address such rejection. Applicant has reviewed the claim, and it is respectfully submitted that the claim satisfies Section 112. It is respectfully requested that the rejection of claim 12 under 35 U.S.C. §112, second paragraph, be withdrawn.

**B. Claims 13-16 and 18 are directed to statutory subject matter under 35 U.S.C. §101.**

According to the Final Office Action<sup>7</sup>, claims 13-16 and 18 are directed to non-statutory subject matter. It is respectfully submitted that claims 13-16 and 18 are directed to a method of psychological/therapeutic treatment constituting statutory subject matter within the scope of §101.

Independent claim 13 recites a “method of exploring emotional experience, comprising the steps of (a) providing a toy …; and (b) interacting with the toy to explore an emotional experience.” (Underlining added for emphasis).

That is, claim 13 relates to a psychological method of treatment that recites specific steps to explore and treat an emotional condition of a patient. Such a method is therapeutic in nature. As discussed above in the Summary of Claimed Subject Matter, providing a toy according to the present invention to explore an emotional experience enhances a person’s (e.g., a child’s) ability to connect a specifically identified emotion to a specific concrete symbol of that emotion (i.e., playpiece) during an otherwise fluid, sometimes overwhelming emotional experience.<sup>8</sup> Enhancing the child’s ability to make this connection between a concrete symbol and a corresponding emotion helps provide an emotional experience that is more manageable and helps an adult (e.g., psychologist) or child plan for responsive actions.<sup>9</sup>

Psychological methods of practice have long been deemed to constitute patentable subject matter. The United States Patent Office (USPTO) even has at least one applicable class and subclass for corresponding patents in this field. For example, reference is made to the many patents in class 434, subclass 236. Just a few representative patents in this class/subclass include:

- U.S. Pat. No. 6,626,678 to Forbes et al. includes, e.g., claim 1, which recites “[a] therapeutic method comprising … to use as a cognitive activity aid an article that comprises a plurality of pieces ....”;

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<sup>7</sup> See id. at page 3.

<sup>8</sup> See the specification at, e.g., page 7, lines 10-15.

<sup>9</sup> See id. at, e.g., page 2, lines 21- 30 and page 7, lines 7-18.

- U.S. Pat. No. 6,540,518 to Shepherd includes, e.g., claim 13, which recites “[a]n educational method of teaching individuals their emotions ....”;
- U.S. Pat. No. 6,626,677 to Morse et al. includes, e.g., claim 1, which recites “[a] method of enhancing work related leadership, communication and creative skills ....”; and
- U.S. Pat. No. 6,602,076 to Adams includes, e.g., claim 1, which recites “[a] method of teaching a fundamental skill to a student ....”

It is not seen how the Examiner can disqualify the claimed subject matter under Section 101 when the USPTO thinks otherwise via patents it has issued and via the class/subclass indexing the USPTO provides for these patents. The claims clearly recite patentable subject matter under Section 101.

The Examiner’s arguments to the contrary not only conflict with established USPTO infrastructure, but also are improperly based upon case law that is inappropriately applied to the present claims. According to the Final Office Action<sup>10</sup>:

Applicants further argue that since patents drawn to psychological methods have been issued that have not achieved a specific tangible result then therefore their method claims are statutory under 35 USC 101. In response the examiner points out that a recently developed test for the determination of patent eligible matter is whether the invention produces a useful, concrete and tangible result. See e.g., State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999).

The Final Office Action also cites *In re Warmerdam*, 31 USPQ2d 1754 (Fed. Cir. 1994) and *In re Schrader*, 30 USPQ2d 1455 (Fed. Cir. 1994) in support of the §101 rejection.<sup>11</sup>

It is respectfully submitted that the line of cases relied on in the Final Office Action<sup>12</sup> apply to mathematical algorithms and, therefore, do not apply to Applicant’s claimed invention. The “useful, concrete, and tangible” test referred to in the Final Office Action<sup>13</sup> above was cited in the *State Street* case with regard to “The ‘Mathematical

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<sup>10</sup> See page 8 of the Final Office Action mailed September 28, 2004.

<sup>11</sup> See id. at page 4.

<sup>12</sup> See id. at pages 4 and 8.

<sup>13</sup> See id. at page 8.

Algorithm' Exception," which is a judicially-created exception to statutory subject matter.<sup>14</sup>

In particular, the test is stated as follows:

In *Diehr*, the Court explained that certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application, i.e., 'a useful, concrete and tangible result.'<sup>15</sup> (Underlining added for emphasis).

And the cases cited in the Final Office Action<sup>16</sup> in support of the §101 rejection also are related to mathematical algorithms as follows:

- *In re Abele*<sup>17</sup>, involves an improvement in CAT scan imaging technique through the use of a weighting function in the calculations producing an image;
- *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*<sup>18</sup>, involves the transformation of data, representing discrete dollar amounts, through a series of mathematical calculations into a final share price;
- *AT&T Corp. v. Excel Communications, Inc.*<sup>19</sup>, involves a long distance telephone billing process that includes applying Boolean algebra to data to determine a value that is used to create a signal useful for billing purposes;
- *In re Warmerdam*<sup>20</sup>, involves a method and apparatus for controlling the motion of objects and machines; and
- *In re Schrader*<sup>21</sup>, involves a method for competitively bidding on items that uses a mathematical algorithm.

To re-emphasize, the present claims do not recite mathematical algorithms per se, but rather embody methods of psychological/therapeutic treatments. The patentability of claims embodying such subject matter is well established. Accordingly, it is respectfully requested that the rejection of claims 13-16 and 18 under 35 U.S.C. §101 be withdrawn.

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<sup>14</sup> See *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

<sup>15</sup> See id. at 1600-01 (citing *In re Alappat*, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994).

<sup>16</sup> See pages 4 and 8 of the Final Office Action mailed September 28, 2004.

<sup>17</sup> 214 USPQ 682, 684 (CCPA 1982).

<sup>18</sup> 47 USPQ2d 1596, 1601 (Fed. Cir. 1998).

<sup>19</sup> 50 USPQ2d 1447, 1452 (Fed. Cir. 1999).

<sup>20</sup> 31 USPQ2d 1754, 1755 (Fed. Cir. 1994).

<sup>21</sup> 30 USPQ2d 1455, 1456, 1458 (Fed. Cir. 1994).

**C. Claims 1, 4, and 6-16 are patentable under 35 U.S.C. §103(a) over Van Hoose in view of Shaver et al.**

Claims 1, 4, and 6-16 stand rejected under 35 USC 103 as being obvious over Van Hoose in view of Shaver et al. Nowhere does Van Hoose teach the use of playpieces having at least the trio of features being claimed. However, in essence, the rejection states that Shaver et al. makes it obvious to incorporate more features into the Van Hoose playpieces in order to arrive at the subject matter of the claims.

This rejection is traversed because:

(1) It is not seen how Shaver et al. can make it obvious to use more features in combination when it is essential to the intended function of the Shaver et al. playpieces that features remain segregated among different groups of playpieces; and further that these groups must be presented to the user in succession, not in integrated fashion; and

(2) Even if the combination were to be made, the claims would not be met in that neither document teaches a playpiece group in which the playpieces are uniquely colored in combination with a unique facial expression.

Independent claims 1 and 13 each recite a particular toy that includes, *inter alia*, a plurality of playpieces such that each playpiece is generally symbolic of a particular emotion and each playpiece has the following combination of features:

- 1) a unique color with respect to the other playpieces,
- 2) a unique shape with respect to the other playpieces, and
- 3) a unique visually discernible facial expression with respect to the other playpieces of the corresponding particular emotion, said facial expression comprising eyes and a mouth.

As acknowledged by the Final Office Action<sup>22</sup>, Van Hoose fails to teach using the combination of all three of these features in the same group of playpieces. Specifically, the objects 29, 31, 33, 35, 37, and 39 disclosed by Van Hoose are not unique in color with respect to each other because both objects 31 (lips) and 35 (heart) are red.<sup>23</sup> Also, none of objects 29, 31, 33, 35, 37, or 39 have a facial expression, especially a unique

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<sup>22</sup> See pages 5 and 6 of the Final Office Action mailed September 28, 2004.

<sup>23</sup> See Van Hoose at col. 2, lines 40-44 and Figure 3.

visually discernible facial expression with respect to the other objects that includes at least eyes and a mouth.<sup>24</sup>

The Shaver et al. reference fails to cure the deficiencies of the Van Hoose reference. It is improper to use Shaver et al. as a basis to combine more features into the playpieces of Van Hoose inasmuch as Shaver actually teaches away from incorporating more features into individual playpieces. It is essential to the intended function of the Shaver et al. apparatus that playpiece features remain segregated to a degree among different playpiece groups, and these different, segregated groups must be presented to the user in succession.

For instance, Shaver et al. disclose a particular receptacle into which certain kinds of objects can be inserted by a child in response to questions.<sup>25</sup> Shaver et al. describe the objects as “a series of sets of disks, with the sets being presented to the child seriatim [i.e., in series].”<sup>26</sup> (Underlining added). More specifically, Shaver et al. describe four sets of disks in FIGS. 9a-9j, 10a-10g, 11a-11j, and 12a-12j.<sup>27</sup> As disclosed in Shaver et al., each disk within each of these sets of disks is unique with respect to the other disks of a given set based on only one aspect.<sup>28</sup> Each disk within the set of disks represented in FIGS. 9a-9j depicts a facial expression expressing an emotion and a child is instructed to select a disk based on how the child feels about an event.<sup>29</sup> Each disk within the set of disks in FIGS. 9a-9j is not unique in color and is not unique in shape. After selecting a disk from the set of disks in FIGS. 9a-9j, a child is asked to select a disk from the set of disks illustrated in FIGS. 10a-10g.<sup>30</sup> Each disk in FIGS. 10a-10g has its own unique color, but does not include a facial expression and is not unique in shape.<sup>31</sup> After selecting a disk from the set of disks in FIGS. 10a-10g, a child is asked to select a disk from the set of disks illustrated in FIGS. 11a-11j or FIGS. 12a-12j to describe the intensity of the child’s feeling.<sup>32</sup> FIGS. 11a-11j illustrate disks having numbers on them

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<sup>24</sup> See Figure 3 of Van Hoose.

<sup>25</sup> See Shaver et al. at the Abstract.

<sup>26</sup> See id. at col. 4, lines 40-42.

<sup>27</sup> See id. at col. 4, line 43 to col. 5, line 13.

<sup>28</sup> Id.

<sup>29</sup> See id. at col. 4, lines 43-49.

<sup>30</sup> See id. at col. 4, lines 58-62.

<sup>31</sup> See id. at col. 4, lines 58 and 59.

<sup>32</sup> See id. at col. 4, line 66 to col. 5, line 3.

and FIGS. 12a-12j illustrate disks having dots on them.<sup>33</sup> Each disk within the set of disks in FIGS. 11a-11j is not unique in color and is not unique in shape.<sup>34</sup> Each disk within the set of disks in FIGS. 12a-12j is not unique in color and is not unique in shape.<sup>35</sup>

Shaver et al. do not cure the deficiencies of Van Hoose because, e.g., Shaver et al. do not disclose a set of disks where each disk has 1) a unique color with respect to the other disks and 2) a unique visually discernible facial expression with respect to the other disks that includes at least eyes and a mouth. As discussed above, Shaver et al. describe two separate sets of disks where each disk in one set has a unique color (FIGS. 10a-10g), yet does not include a facial expression, and each disk in the other set has a unique facial expression (FIGS. 9a-9j), yet does not include a unique color.

There is no motivation or suggestion to modify a set of disks described by Shaver et al. such that each disk in the set has 1) a unique color with respect to the other disks and 2) a unique visually discernible facial expression with respect to the other disks that includes at least eyes and a mouth because that would be contrary to the specific instructions of Shaver et al. As discussed above, Shaver et al. specifically instruct one skilled in the art to first present a child with a first set of disks (FIGS. 9a-9j), then a second set of disks (FIGS. 10a-10g), and then a third set of disks (FIGS. 11a-11j or FIGS. 12a-12j).<sup>36</sup> As also discussed above, each disk in the set illustrated in FIGS. 9a-9j has a unique facial expression with respect to the other disks, yet does not have a unique color, and each disk in the set illustrated in FIGS. 10a-10g has a unique color, yet does not even have facial expression.

Cases #1 and #2 described in Shaver et al. highlight why Shaver et al. instruct one skilled in the art to use such separate sets of disks. In Case #1, a patient selected a disk having a unique facial expression based on how she felt about an event and then selected a disk having a unique color from a separate set of disks based on how she felt about the event.<sup>37</sup> The patient selected a facial expression disk representing sad and a blue colored disk.<sup>38</sup> As can be seen, the patient herself selected a facial expression and a color based

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<sup>33</sup> See id. at col. 5, lines 3-6.

<sup>34</sup> Id.

<sup>35</sup> Id.

<sup>36</sup> See id. at col. 4, line 43 to col. 5, line 13.

<sup>37</sup> See id. at col. 4, lines 44-64.

<sup>38</sup> See id. at col. 4, lines 49-53.

on how she felt. If a single set of disks were given to her where each disk was unique in color and facial expression, the combination would have to be anticipated, which is impossible, and pre-selected by someone other than the patient, which is contrary to the teachings of Shaver et al.

In Case #2, a patient selected a disk depicting a scared face because he felt scared and a brown disk from a separate set of disks because he had brown hair and eyes.<sup>39</sup> As can be similarly seen, the patient himself selected a facial expression and a color. Moreover, in Case #2, the patient selected a color based on the color of his hair and eyes, not how he felt. If a single set of disks were given to him where each disk was unique in color and facial expression, the combination would have to be anticipated, which is impossible, and pre-selected by someone other than the patient, which is contrary to the teachings of Shaver et al.

It is not seen how Shaver et al. can provide any teaching, motivation or suggestion to incorporate more features into the same playpiece group of Van Hoose when the Shaver et al. reference itself purposely segregates playpiece features among successive playpiece groups. It is not seen how Shaver et al. can provide any teaching, motivation or suggestion to incorporate more features into the same playpiece group of Van Hoose when doing so undermines the essential functionality of the Shaver et al. apparatus.

In addition, it is respectfully submitted that even if the Van Hoose reference is combined with Shaver et al. reference, the resultant combination would lack a playpiece group in which the playpieces are uniquely colored in combination with a unique facial expression. As discussed above, the Van Hoose objects are not unique in color and do not have a facial expression, and the disks having unique color and facial expressions in Shaver et al. are in separate sets of disks, respectively. Therefore, because Van Hoose and Shaver et al., alone or in combination, do not teach, motivate, or suggest all of the claim features in claim 1 or claim 13, a *prima facie* case of obviousness has not been established.

Accordingly, it is respectfully requested that the rejection of claims 1, 4, and 6-16 under 35 U.S.C. §103(a) as being unpatentable over Van Hoose in view of Shaver et al. be withdrawn.

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<sup>39</sup> See id. at col.5, line 66 to col. 6, line 16.

**D. Claims 17 and 18 are patentable under 35 U.S.C. §103(a) over Van Hoose in view of Shaver et al. and further in view of Childswork/Childsplay “Feelings” Frog game.**

Claims 17 and 18 stand rejected under 35 U.S.C. §103(a) as being obvious over Van Hoose in view of Shaver et al. and further in view of Childswork/Childsplay “Feelings” Frog game. Claims 17 and 18 depend from independent claims 1 and 13, respectively. As discussed above, claims 1 and 13 are patentable over Van Hoose in view of Shaver et al. so this rejection is first addressed with respect to claims 1 and 13.

Claims 1 and 13 are also patentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference because the Childswork/Childsplay reference does not overcome the shortcomings of Van Hoose and Shaver as detailed above. More specifically, Childswork/Childsplay reference fails to teach, motivate or suggest modifying the objects 29, 31, 33, 35, 37, and 39 disclosed in Van Hoose so that they have the following claimed combination of all three features: a unique color with respect to each other, a unique shape with respect to each other, and a unique visually discernible facial expression with respect to the other objects that includes at least eyes and a mouth.

The Childswork/Childsplay reference discloses six frogs where each frog has the same set of eyes, yet no mouth, has textual information indicative of a different emotion, is unique in color, yet all six frogs have the same body shape.<sup>40</sup>

First, there is no motivation or suggestion to modify the objects 29, 31, 33, 35, 37, and 39 disclosed in Van Hoose so that they are unique in color based on the Childswork/Childsplay reference. As discussed above, the lips 31 and heart 35 disclosed in Van Hoose are both red. The lips 31 and heart 35 can be distinguished from each other based on shape. The frogs disclosed in Childswork/Childsplay are all the same shape but can be distinguished based on color and textual information. The Childswork/Childsplay reference provides no guidance or reason for one of skill in the art to change to the color of lips 31 and/or heart 35 from red to another color so that the objects are unique in color.

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<sup>40</sup> See the Childswork/Childsplay reference at page 22.

Indeed, absent instructions to the contrary, symbols of lips and hearts are commonly associated with the color red.

Second, the frogs disclosed in the Childswork/Childsplay reference do not have a unique visually discernible facial expression with respect to the other frogs of a corresponding particular emotion where the facial expression includes at least eyes and a mouth, as required by Applicant's claims. The frogs disclosed in the Childswork/Childsplay reference all have the same sets of eyes, which are not indicative of the corresponding emotion displayed in the text.<sup>41</sup> Moreover, the Childswork/Childsplay reference does not unambiguously describe that the frogs even have a mouth.

There is no motivation or suggestion to modify the frogs in the Childswork/Childsplay reference to have a unique visually discernible facial expression with respect to the other frogs of a corresponding particular emotion where the facial expression includes at least eyes and a mouth, as required by Applicant's claims. Indeed, the Office Action merely relied on the Childswork/Childsplay reference as disclosing frogs with unique color and having textual information indicative of a particular emotion.<sup>42</sup>

Finally, as noted above, the Childswork/Childsplay reference illustrates the frogs as all having the same shape.<sup>43</sup> Therefore, modifying the objects 29, 31, 33, 35, 37, and 39 disclosed in Van Hoose with the frogs disclosed in Childswork/Childsplay teaches away Applicant's claims.

Accordingly, it is respectfully submitted that claims 1 and 13 are patentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference. Likewise, it is respectfully submitted that dependent claims 17 and 18 are also patentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference.

It is respectfully requested that the rejection of claims 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference be withdrawn.

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<sup>41</sup> Id.

<sup>42</sup> See page 7 of the Final Office Action mailed September 28, 2004.

<sup>43</sup> See the Childswork/Childsplay reference at page 22.

**E. Conclusion**

In view of these remarks, it is respectfully submitted that pending claims 1, 4, and 6-18 are in condition for allowance.

Respectfully Submitted,

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## **VIII. Appendix – Claims on Appeal**

1. (previously presented) An interactive toy for exploring an emotional experience, comprising:
  - (a) a plurality of playpieces, each playpiece being generally symbolic of a particular emotion, and each playpiece comprising a unique color with respect to the other playpieces, a unique shape with respect to the other playpieces, and unique visually discernible facial expression with respect to the other playpieces of the corresponding particular emotion, said facial expression comprising eyes and a mouth; and
  - (b) a container comprising a storage chamber into which the playpieces may be independently stored or withdrawn during the course of play thereby providing the opportunity for emotions to be kinesthetically represented.

2-3. (canceled)

4. (previously presented) The interactive toy of claim 1, wherein the playpieces comprise a first playpiece generally symbolic of love, a second playpiece generally symbolic of sadness, a third playpiece generally symbolic of happiness, a fourth playpiece generally symbolic of anger, and a fifth playpiece generally symbolic of fear.

5. (canceled)

6. (previously presented) The interactive toy of claim 4, wherein the playpiece generally symbolic of sadness is tear drop-shaped.

7. (previously presented) The interactive toy of claim 4, wherein the playpiece generally symbolic of happiness is sun-shaped.

8. (previously presented) The interactive toy of claim 4, wherein the playpiece generally symbolic of anger is fire-shaped.

9. (previously presented) The interactive toy of claim 4, wherein the playpiece generally symbolic of fear is ghost-shaped.

10. (original) The interactive toy of claim 1, wherein one or more of the playpieces each respectively comprises one or more panels enclosing a stuffing material.

11. (original) The interactive toy of claim 1, wherein the container is heart-shaped.

12. (original) The interactive toy of claim 1, wherein the container is a plush, pillow bag.

13. (previously presented) A method of exploring emotional experience, comprising the steps of:

- (a) providing a toy comprising a plurality of playpieces, each playpiece being generally symbolic of a particular emotion and each playpiece comprising a unique color with respect to the other playpieces, a unique shape with respect to the other playpieces, and unique visually discernible facial expression with respect to the other playpieces of the corresponding particular emotion, said facial expression comprising eyes and a mouth, and a container comprising a storage chamber into which the playpieces may be independently stored or withdrawn during the course of play; and
- (b) interacting with the toy to explore an emotional experience.

14. (previously presented) The method of claim 13, wherein interacting with the toy comprises visually, kinesthetically, and linguistically exploring an emotional experience.

15. (previously presented) The method of claim 13, wherein step (b) comprises withdrawing a playpiece from the container.

16. (original) The method of claim 13, further comprising naming the emotion corresponding to the playpiece.

17. (previously presented) The interactive toy of claim 1, wherein each playpiece further comprises textual information indicative of the particular emotion corresponding to the playpiece.
18. (previously presented) The method of claim 13, wherein each playpiece further comprises textual information indicative of the particular emotion corresponding to the playpiece.

## **IX. Appendix - Evidence**

There is no evidence to be included in Appendix IX.

## **X. Appendix - Related Proceedings**

As indicated in Section II, there are no related appeals or interferences.